

REMARKS

Claims 1 through 60 are pending in the application. Claim 16 is amended.

I. Objection To Format Of Amendments Under 37 C.F.R. §1.173

Applicant notes that the Examiner objected to the earlier filed Amendments as improperly underlining and bracketing the amendments to the specification and the claims. The Examiner's attention is directed to 37 C.F.R. §1.121(a) which specifically states that this rule applies to "amendments in applications, *other than reissue applications.*" Moreover, 37 C.F.R. §1.121(h) expressly states that "*Any* amendment to description and the claims in reissue application *must* be made in accordance with §1.173". 37 CFR §1.173 defines the style and format of amendments in reissue applications, not 37 CFR §1.121.

In Paper No. 15, the Examiner correctly notes that amendments are presented to allowed claims 1 and 16 which had not previously been entered. The Examiner is correct and the amendments should not have been presented in the Response of the 27th of November. Those amendments were inadvertently taken from a different draft, and should not have been included.

RS [The instant amendment presents claims 1 and 16 as amended, with one change proposed to independent allowed claim 16 in order to assure consistent antecedent basis throughout. There are no marked-up copies of amendments of original claims in re-issue applications, under 37 CFR §1.173. All of the pending claims 1 through 60 are presented in the foregoing pages, ready for printing; these claims are marked in accordance with 37 CFR §1.173(b) and (d) with the matter to be added underlined and the matter to be deleted bracketed. It is respectfully submitted

that the manner in which Applicant has presented these amendments is in full compliance with 37 C.F.R. §1.173; accordingly, it is respectfully requested that this objection be withdrawn.

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Concerning claims 21 through 60, these claims have been presented as completely underlined in accordance with 37 CFR §1.173(d)(2). No undisclosed changes have been made in claims 21 through 60.

All of the pending claims 1 through 60 are presented.

II. Rejection of Claims 21-51 Under 35 U.S.C. §251

In paragraph 2 of the Office action, the Examiner rejected claims 21 through 51 under 35 U.S.C. §251 “as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based.” Applicant respectfully traverses this rejection for at least the following reasons.

A. 35 U.S.C. §251 Allows Reissue Claims That Are Broader in Scope Than The Patented Claims

Nothing in 35 U.S.C. §251 defines either “recapture” or prohibits “recapture”. §251 does however, expressly provides for *broadening* of the scope of the claims of the original patent. Applicant is within the express grant of entitlement to seek broadened claims in this reissue application. In support of this rejection, the Examiner cited *Hester Industries, Inc. v. Stein, Inc.*, 46 USPQ2d 1441 (Fed. Cir. 1998); *In re Clement*, 45 USPQ2d 1161 (Fed. Cir. 1997) and *Ball Corp. v. United States*, 221 USPQ 289, 295 (Fed. Cir. 1984). During the office interview, the Examiner stated that he was not familiar with these judicial decisions, and had not read these

decisions, and explained that the citation of these three decisions was simply part of the form paragraph used in the rejection. For the benefit of the Examiner, Applicant explains that these decisions fail to support the Examiner's rejections.

By way of example, in *Ball Corp.*, the Court of Appeals for the Federal Circuit rejected the Government's assertion of a recapture type of estoppel, where the Applicant filed a reissue application within the two-year period for broadened reissue. The Court ruled that the doctrine of recapture "will not bar *Ball* from securing the reissued claims here on appeal" where the reissue claims were "broader than the claims of the original patent yet narrower than the cancelled claims" in the original patent application. Although the Court of Appeals found that the claims cancelled in the original application were "limited to an antenna of cylindrical configuration, whereas the reissued claims were not so limited," the Court spurned the government's assertion that recapture occurred because the reissued claims were not also limited to a cylindrical configuration, and held that the Applicant was entitled to obtain reissued claims that covered antennas that were not in a cylindrical configuration.

That holding is applicable here, where the Examiner seeks to reject Applicant's claims in a situation very similar to *Ball*, by imposing a theory of recapture estoppel to support rejections of reissue claims for failure to include such limitations as "first and second projections defining "first and second air bearing surfaces; "arcuate front wall portion" and "third and fourth air bearing surfaces" as were set forth in Applicant's original claims 1 through 10 and 14, which were rejected in Paper No. 4 in parent application Serial No. 08/915,342 as "being clearly anticipated by Chapin *et al.* (5,200,868)." The fallacy in the Examiner's rejection lies in the fact

that these limitations were already present in rejected claims 1 through 10, and were not added in an amendment to overcome the anticipation rejection. Moreover, Applicant amended independent claim 1 to broaden the scope of coverage by, for example, changing the phrase “curved front wall portion” to the broader phrase “arcuate front wall”; and making a wholesale deletion of the clause “curved front wall portion and said first and second curved wall portions being spaced apart from said first and second projections, wherein the first and second curved sidewall portions respectively extend along said first and second side portions of said principal surface”. Applicant also made other broadening amendments in claim 1. In response to Applicant’s demonstration in the *Remarks* of Paper No. 6, of the absence of anticipation, the Examiner withdrew the rejection under 35 U.S.C. §102(b), and allowed the broadened amended claim 1, together with claims 2 through 10 and 14. No basis for “recapture” occurred. Withdrawal of this rejection is therefore, required.

B. 35 U.S.C. §251 Does Not Require That Reissue Claims Which Are Broader in Scope Than The Patented Claims Contain All Of The Constituent Elements Of A Parent Patent Claim

In support of this rejection, the Examiner states that:

The following limitations have been omitted from the newly presented reissue claims: “first and second projections” defining “first and second air bearing surfaces” (claims 21, 31, 42, 52, 55 and 58); “arcuate front wall portion” (claims 21, 31, as now amended 42, 52, 55, and 58), and “third and fourth air bearing surfaces” (claims 21, 52, 55, and 58).

In the amendment of 12/01/98 in the parent application Applicant specifically argued (see remarks on pages 11-12) the

following structural features to defined over the 102 rejection based upon CHAPIN et al (5,200,868): (a) an arcuate front wall, (b) third and fourth air bearing surfaces, and (c) four separate air bearing surfaces.”

Applicant respectfully invites the Examiner’s attention to the language of 35 U.S.C. §251, which expressly contemplates the right of an applicant to be granted a:

“reissued patent ... *enlarging the scope* of the claims of the original patent” 35 U.S.C. §251 (emphasis added).

The Examiner’s reasoning seeks to incorrectly place a restriction upon the Applicant’s right, by asserting that 35 U.S.C. §251 *sub silentio*, creates an estoppel that requires that claims that enlarge the scope of the claims of the original patent be allowable for the identical reasons argued by an applicant in support of the allowability of the original claims. This is not the law under 35 U.S.C. §251. Accordingly, this rejection can not be maintained.

C. 35 U.S.C. §251 Does Not Prohibit Allowance Of Reissue Claims That Are Patentably Distinguishable Over The Prior Art For Reasons Different From The Patented Claims

Another flaw in this rejection of reissue claims 21 through 60 is that the Examiner’s expressed rationale is wholly unsupported by either statute, rule of the Commissioner, or judicial interpretation of the statute. When the Examiner asserts that:

“[t]he following limitations have been omitted from the newly presented reissue claims: “first and second projections” defining “first and second air bearing surfaces” amended 42, 52, 55, 58), and “third and fourth air bearing surfaces” (claims 21, 52, 55, and 58).”

the Examiner ignores the absence in 35 U.S.C. §251 of any language that prohibits the allowance

of reissue claims that are patentably distinguishable over the prior art for reasons that are different from those reasons that distinguish the patented claims from the prior art. When the Examiner states that,

“[I]n the amendment of 12/01/98 in the parent application Applicant specifically argued (see remarks on pages 11-12) the following structural features to defined over the 102 rejection based upon CHAPIN et al (5,200,868): (a) an arcuate front wall, (b) third and fourth air bearing surfaces, and (c) four separate air bearing surfaces”,

the Examiner is improperly endeavoring to limit a reissue applicant to only those reissue claims that are patentably distinguishable over the prior art for the very same reasons as the patented claims. This necessarily limits the applicant to the presentation of reissue claims that are coincidental in breath and scope to the patented claims; such reissue claims would be essentially duplicates of the patented claims. The Examiner’s endeavor ignores the express grant by 35 U.S.C. §251 of the patentee’s right to obtain broader claims within a two year period after the issue of the patented claims. In short, the Examiner has no grant of authority under 35 U.S.C. §251 to reject claims of enlarging scope that are allowable for reasons not enunciated by an applicant during the examination of the original patent either in the *Remarks* or in an *Appeal Brief*, or by the Board in a *Decision on an Appeal*. The Examiner’s statement that claims 21 through 60 are unpatentable under 35 U.S.C. §251 because:

“[t]he following limitations have been omitted from the newly presented reissue claims: “first and second projections” defining “first and second air bearing surfaces” (claims 21, 31, 42, 52, 55, and 58); “arcuate front wall portion” (claims 21, 31, as now amended 42, 52, 55, and 58), and “third and fourth air bearing surfaces” (claims 21, 52, 55, and 58).”

is specious. Accordingly, there is no lawful basis for maintaining a rejection of reissue claims of enlarging scope, even if those claims are allowable for reasons other than those either argued by the Applicant or stated by the Board of Appeals, during prosecution of the original patent. Withdrawal of this rejection and allowance of claims 21 through 60, is therefore requested.

D. A Rejection Alleging Improper Recapture Under 35 U.S.C. §251 Must Follow The Procedures of the United States Patent & Trademark Office

A second flaw in the Examiner's reasoning lies in the Examiner's failure to recognize that nothing was surrendered during prosecution of the parent application. The Office action has alleged recapture without following the procedure mandated by the Commissioner. Application of the doctrine of recapture requires that the Examiner follow well defined procedural steps. Judicial interpretations of 35 U.S.C. §251 such as that set forth in *Pannu v. Storz Instruments Inc.*, 59 USPQ2d @ 1600 (Fed. Cir. 2001) earlier cited by the Examiner, details the three-step process for application of the recapture rule. The first step is to:

“determine whether and in what aspect the reissue claims are broader than the patent claims,”

and the second step

“is to determine whether the broader aspects of the reissued claim relate to surrendered subject matter.”

As explained in §1412.02 of the *Manual of Patent Examining Procedure* (8th edition) (August 2001)),

“The first step in applying the recapture rule is to determine whether and in what aspect the reissue claims are broader than the

patent claims.” *MPEP* §1412.02.

“The second step is to determine whether the broader aspects of the reissue claims relate to surrendered subject matter.” *MPEP* §1412.02.

The *Manual* instructs the Examiner that, in order:

“To determine whether an Applicant surrendered particular subject matter, we look at the prosecution history for arguments and changes to the claims made *in an effort to overcome* a prior art rejection.” *MPEP* §1412.02.

The practice outlined by the *Manual* is mandatory.

This rejection action is incomplete under 37 CFR §1.104(b) and (c) because the action not only fails to identify “in what **aspect** the reissue claims are broader than the patented claims” (that is, to make the first step required by *MPEP* §1412.02), but more significantly, fails “to determine whether the broader aspects of the reissued claims relate to surrendered subject matter” (the second step set forth in *MPEP* §1412.02). When the Examiner writes that:

“[t]he following limitations have been omitted from the newly presented reissue claims: “first and second projections” defining “first and second air bearing surfaces” amended 42, 52, 55, 58), and “third and fourth air bearing surfaces” (claims 21, 52, 55, and 58).”

and that:

“[I]n the amendment of 12/01/98 in the parent application Applicant specifically argued (see remarks on pages 11-12) the following structural features to defined over the 102 rejection based upon CHAPIN et al (5,200,868): (a) an arcuate front wall, (b) third and fourth air bearing surfaces, and (c) four separate air bearing surfaces”,

the Examiner is not complying with the first step of the mandatory procedural requirement of

MPEP §1412.02) (to “determine whether and in what aspect the reissue claims are broader than the patent claims,”) because several of these features are present in both the patent claims as well as in the reissue claims. In short, this Office action has failed to determine in what aspect the reissue claims are broader than the patent claims as is required by the first step of *MPEP* §1412.02.

Moreover, the foregoing statements by the Examiner fail to comply with the second procedural step of *MPEP* §1412.02 by identifying any surrendered subject matter among those aspects that make the reissue claims broader than the patent claims. As was discussed in Applicant’s response of the 9th of October 2002, the failure of the Office action to identify surrendered subject matter is directly attributable to the fact that careful examination of the prosecution history establishes an absence of any evidence of record of the occurrence of a surrender of any subject matter during prosecution of the parent application.

Turning now to a review of the amendments made by the Applicant during the prosecution of the original patent, §1412.02 of the *Manual of Patent Examining Procedure* (8th edition) (August 2001)) instructs the Examiner, that:

“[t]o determine *whether* an Applicant surrendered particular subject matter, we look at the prosecution history for *arguments and changes* to the claims made *in an effort to overcome* a prior art rejection.” *MPEP* §1412.02.

The accompanying table illustrates the progress of examination of claim 1 in the parent patent application, which continues to be numbered as claim 1, and, ignoring *arguendo* the issue of whether or not the doctrine may be applied to support a recapture, graphically illustrates the absence in the prosecution history of “*arguments and changes* to the claims made *in an effort to*

overcome a prior art rejection” that are requisite to invocation of the doctrine of recapture.

TABLE I

<u>Claim 1</u>	<u>Claim 1</u>
<u>Before 12/01/98 Amendment</u>	<u>After 12/01/98 Amendment</u>
first and second projections ... to define first and second air bearing surfaces (lines 10, 11)	No change of this clause. (lines 10, 11)
curved front wall portion (lines 15, 16)	arcuate front wall portion (lines 15, 16)
so as to define a rounded (line 20)	The Amendment completely deleted this limitation.
curved front wall portion and said first and second curved side wall portions being spaced apart from said first and second projections (lines 22-24)	The Amendment completely deleted this limitation.
wherein the first and second curved side wall portions respectively extend along said first and second side portions of said principal surface and define (lines 24, 25)	The Amendment completely deleted this limitation.
third and fourth air bearing surfaces located at a rear portion of said principal surface (lines 25, 26)	third and fourth air bearing surfaces (lines 25, 26)
located at said rear portion of said principal surface (line 26)	The Amendment completely deleted this limitation.
at a position central located in the lateral (line 32)	The Amendment completely deleted this limitation.

As illustrated by the table, no narrowing amendments were made to the language of the three constituent elements now cited by the Examiner as triggering a recapture. Absent narrowing amendments of any of these three constituent elements, there was no surrender in the scope of coverage.

Moreover, as illustrated by the table, claim 1 was elsewhere broadened in scope by amendment to broaden the original definition of "third and fourth air bearing surfaces located at a

rear portion of said principal surface" to add the phrase "said first and second wall portions terminating at said rear portion of said principle [sic, principal] surface of said slider body for defining" before the original phrase "third and fourth air bearing surfaces." This amendment broadened the scope of claim 1 by completely deleting any reference to the "rear portion" limitation." Claim 1 was further broadened in scope by completely deleting such limitations as "curved front wall portion and said first and second curved side wall portions being spaced apart from said first and second projections" from lines 22-24, and

The Amendment of the 1st of December 1998 was filed in response to an Office Action (Paper No 4) dated on the 1st of September 1998, that made a single art rejection of claims 1 through 10 and 14 under 35 U.S.C. §102(b) "as being clearly anticipated by CHAPIN et al (5,200,868). Note the embodiment in figure 3j" *Examiner's Comments*, page 2. The Amendment of the 1st of December 1998 contained clarifying, rather than *Festo* type substantive amendments, to substitute "arcuate" for "curved" in line 15 of claim 1.

Subsequently, claims 1, 3, 7, 9 through 19 and 21 through 25 were allowed by Paper No. 8, a Notice of Allowance issued on the 7th of December 1998.

Patented claims 1 through 15 did not recite the clause "four separate air bearing surfaces" when originally presented or when amended; these claims do not now contain that clause. That claim appears only in patented claim 16, lines 24, 25, which was added in the Amendment of the 1st of December 1998 and never rejected. Hence, even ignoring the doctrine of claim differentiation, claim 21 provides no basis for the Examiner to assert that the doctrine of recapture requires the presence of this clause in the re-issue claims, because that clause was

neither added to patented claims 1 through 15 during prosecution in an effort to avoid a prior art rejection, nor was that clause argued during prosecution as patently distinguishing patent claims 1 through 15 over the prior art. In short, that clause was not present and its wording was not an issue. The doctrine of recapture provides no basis for asserting that the clause “four separate air bearing surfaces” should be present in the reissue claims 21 through 60, because that clause was never present in all of the patented claims when those claims were first rejected. Consequently, that clause was not both added to all of the claims and then argued “*in an effort to overcome a prior art rejection*” as is required by Office practice defined by *MPEP* §1412.02, as is established by the following analysis represented by Tables II and III:

TABLE II

<u>Claim 1</u>	<u>Claim 1</u>	<u>Claim 21</u>
<u>Before 12/01/98 Amendment</u>	<u>After 12/01/98 Amendment</u>	<u>As Finally Rejected</u>
first and second projections ... to define first and second air bearing surfaces (lines 10, 11)	No change of this clause. (lines 10, 11)	No comparable limitation.
curved front wall portion (lines 15, 16)	arcuate front wall portion (lines 15, 16)	U-shaped air-bearing platform (line 9)
so as to define a rounded (line 20)	The Amendment completely deleted this limitation.	No comparable limitation.
curved front wall portion and said first and second curved side wall portions being spaced apart from said first and second projections (lines 22-24)	The Amendment completely deleted this limitation.	No comparable limitation.

wherein the first and second curved side wall portions respectively extend along said first and second side portions of said principal surface and define (lines 24, 25)	The Amendment completely deleted this limitation.	No comparable limitation.
third and fourth air bearing surfaces located at a rear portion of said principal surface (lines 25, 26)	third and fourth air bearing surfaces (lines 25, 26)	comprising not more than two separate air bearing platforms (line 9)
located at said rear portion of said principal surface (line 26)	The Amendment completely deleted this limitation.	No comparable limitation.
at a position central located in the lateral (line 32)	The Amendment completely deleted this limitation.	No comparable limitation.

TABLE III

<u>Claim 1</u>	<u>Claim 1</u>	<u>Claim 31</u>
<u>Before 12/01/98 Amendment</u>	<u>After 12/01/98 Amendment</u>	<u>As Finally Rejected</u>
first and second projections ... to define first and second air bearing surfaces (lines 10, 11)	No change of this clause. (lines 10, 11)	No comparable limitation.
curved front wall portion (lines 15, 16)	arcuate front wall portion (lines 15, 16)	U-shaped air-bearing platform (line 10)
so as to define a rounded (line 20)	The Amendment completely deleted this limitation.	No comparable limitation.
curved front wall portion and said first and second curved side wall portions being spaced apart from said first and second projections (lines 22-24)	The Amendment completely deleted this limitation.	No comparable limitation.

wherein the first and second curved side wall portions respectively extend along said first and second side portions of said principal surface and define (lines 24, 25)	The Amendment completely deleted this limitation.	No comparable limitation.
third and fourth air bearing surfaces located at a rear portion of said principal surface (lines 25, 26)	third and fourth air bearing surfaces (lines 25, 26)	comprising not more than two separate air bearing platforms (line 9)
located at said rear portion of said principal surface (line 26)	The Amendment completely deleted this limitation.	No comparable limitation.
at a position central located in the lateral (line 32)	The Amendment completely deleted this limitation.	No comparable limitation.

Reference to the amendments made during prosecution of the original patent in the light of the foregoing table establishes that the phrases “a curved frontwall”, and “third and fourth air bearing surfaces” were already present in the claims prior to the first Office action. All of these phrases were present in the pending claims prior to issuance of the first Office action; as is explained in greater detail below, none of these phrases could be said to have been added to the claims by amendment in order “to overcome such prior art applied in the application which matured into the parent for which reissue is being sought”, as is explained by §706.02(l)(1) of the *Manual*.

In Paper No. 15, the Advisory Action dated 5 December 2002, the Examiner stated “that the tables presented by Applicant’s attorney are misleading and misdescriptive when they state that certain limitations were cancelled without acknowledging that replacement recitations for these were added in differen [*sic*, different?] places in those claims.” The Examiner’s use of

“claims” in the plural number is incorrect; only original patent claim 1 is at issue.

Second, the Examiner’s comments suggest that the deleted limitations were inserted elsewhere in the amended claim 1; this is not the case. The bulk of the deleted limitations, based upon actual word count, were deleted in their entirety. Moreover, the Examiner’s comment in Paper No. 15 misses the issue of the Examiner’s theory of the existence of a recapture estoppel. Table 1 illustrates that even ignoring *arguendo*, the absence of any doctrine of recapture estoppel, as opposed to an improper recapture of surrendered subject matter under 35 U.S.C. §251, the Examiner’s theory of recapture estoppel is ill-founded simply because the two to for aspects of claim 1 alternatively listed by the Examiner as being required to be included within any reissue claim in order to prevent recapture estoppel, were amended to more broadly define those aspects of claim 1 after entry of the amendment of 1 December 1998, even though other amendments to other aspects of claim 1 may have been made by Appellant.

Third, the Examiner’s comment also misses the overriding issue that claims 21 through 60 define subject matter different from that defined by patent claim 1. The Examiner’s attempt to gauge allowability of reissue claims on the basis of a limitation-by-limitation comparison of the patent claim to each of the reissued claims is contrary to the procedure required by the Commissioner and improper. Under the Examiner’s theory of recapture estoppel, the single definition given by the patent claim is the sole gauge of allowability of each reissued claim. A practical implementation of the Examiner’s theory forces each reissue claim to be narrower than the patent claim, regardless of the express contemplation of broader reissue claims under 35 U.S.C. §251. In essence, the Examiner’s theory of recapture estoppel is the “very literalism” that

Justice Kennedy complained of when reversing the decision of the United States Court of Appeals for the Federal Circuit and its theory of prosecution history estoppel under the doctrine of equivalence, in *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 122 S.Ct. 1831, 1841 (2002); reviewed in *Harvard Law Review*, Vol. 116 @ 405 (2002). These tables are presented not only to show that the features and aspects claimed by the Examiner to be critical on the issue of surrender, claim 1 was broadened by the amendment of 1 December 1998, and to show that independent claims 21 and 31 are directed to structures that are different from those defined by claim 1.

Turning now from the amendments and examining the remarks made by the Applicant during the prosecution of the original patent, in the *Remarks* of Applicant's response filed on the 1st of December 1998, Applicant traversed the rejections of claims 1 through 15 for several "reason(s)", as was explained on pages 11 and 12 of that response. These reasons were given in the alternative, and any one of these reasons was separately sufficient to require a withdrawal of the rejections of claims 1 through 15:

First, in those *Remarks* Applicant explained that the Examiner's reliance upon Chapin et al. '868 to support a rejection of claim 1 under 35 U.S.C. §102(b) was incorrect, because Chapin '868 lacked several of the features of the parent claim 1.

Second, those *Remarks* explained that the Examiner's rejection of these claims by alternative reference to differences between side rails 20, 22 of Chapin '868 the terms of the rejection of method claim 8 was an incomplete rejection, leading from the leading to the trailing edge of Chapin's air bearing slider, and thus the field of the subject matter

covered by Applicant's claim 1 was quite different.

Third, in the *Remarks* Applicant explained that Chapin '868 relied upon by the Examiner to support the several rejection under 35 U.S.C. §102(b), lacked Applicant's "two trailing platforms 110c and 110b, [that] are connected by cross rail 130 to create a negative pressure pocket", and could not make a *prima facie* showing of anticipation. These features were already present in independent apparatus claims 1 through 15 prior to the rejection.

Accordingly, Applicant's *Remarks* in the response dated on the 1st of December 1998 traversing "the rejections of claims 1 through 15 for several "reason(s)" do not constitute the joint acts of "arguments **and** changes to the claims made in an effort to overcome a prior art rejection" that are requisite to invocation of the doctrine of recapture under the mandatory procedure of *MPEP* §1412.02. The Examiner must therefore, re-examine reissue claims 21 through 60 in accordance with *MPEP* §1412.02. The *Manual* explains the "criteria for determining that subject matter has been surrendered", by stating that:

"[i]f the limitation now being omitted or broadened in the present reissue was originally presented/argued/stated in the original application to make the claims allowable over a rejection or objection made in the original application, the omitted limitation relates to subject matter previously surrendered by applicant, and impermissible recapture exists. *MPEP* §1412.02.

These criteria are not met where the claims in the original application were allowed, without substantive amendment, over the applied prior art, and Applicant's very brief *Remarks* simply demonstrated numerous, alternative features of the original claims that each separately served to distinguish those claims from the prior art. In short, where the original claims are allowable over

the prior art because the prior art fails to make a *prima facie* showing, the multiple act criteria required by the *Manual* are not satisfied. Applicant submits however, that in view of absence of the *Manual*'s multiple acts of a "limitation ... [that] was originally presented/argued/stated in the original application to make the claims allowable", and the demonstrated absence of the joint acts of "*arguments and changes* to the claims made *in an effort to overcome* a prior art rejection", no *impermissible* recapture exists under the *Manual*'s criteria; this rejection must be withdrawn and claims 21 through 60 allowed. Such action is respectfully requested.

D. Where Applicant correctly demonstrates that the prior art fails to teach what the Office action represented that art as teaching, Applicant's demonstration of that failure does not thereafter create a recapture estoppel that restricts the scope of reissue coverage to claims that recite what was lacking in the prior art

As is explained in the foregoing paragraphs, in the Amendment filed on the 1st of December 1998, Applicant correctly explained that the two, alternative primary references relied upon by the Examiner to support the rejection under 35 U.S.C. §102(b), lacked several particular structural components of independent apparatus claim 1 of anticipation. Applicant's demonstration of the numerous deficiencies in the Examiner's rejections however, does not establish the "surrender" that is an essential condition prerequisite to invocation of the doctrine of recapture. Nowhere did Applicant argue that the features missing from the Examiner's art served to patentably distinguish a patent claim over the prior art; in the Amendment filed on the 1st of December 1998, Applicant simply demonstrated that there were multiple deficiencies in the art cited by the Examiner, and that those numerous deficiencies prevented the prior art from supporting a rejection under 35 U.S.C. §102(b). The fact that Applicant separately, and

alternatively noted that any of these exemplary deficiencies required withdrawal of the rejections, does not create any basis for invoking the doctrine of recapture because Applicant simply demonstrated the impropriety of the rejection.

By way of a simplified analogy, if the Examiner had cited the first U.S. Patent Grant issued by George Washington on the 31st of July 1790 to Samuel Hopkins for his *Discovery in the Making of Potash and Pearl Ash* to support a rejection of claims 2 through 7 and 9 under 35 U.S.C. §102(b), and if, in the Amendment filed on the 1st of December 1998, Applicant had explained to the Examiner that the rejection was improper because Hopkins '001 lacked either an *U-shaped projection...including an arcuate front wall, or third and fourth air bearing surfaces*, neither 35 U.S.C. §251 nor the doctrine of recapture would thereafter require all of Applicant's reissue claims to contain either an *U-shaped projection...including an arcuate front wall, or third and fourth air bearing surfaces*. Applicant's citation of at least three distinct features, found to be lacking in the Examiner's art does not mean that thereever after, reissue claims are limited to combinations that include one or more of these elements, particularly where the prior art not only lacked these elements, but could not have used these elements in the practice of their respective intended modes of operation. The mere fact that Applicant correctly demonstrated to the Examiner, that the prior art failed to teach what the Office action represented that art as teaching, does not thereafter create a recapture estoppel that restricts the scope of reissue coverage to claims that recite what was lacking in the prior art.

Moreover, the fact that the phrase four separate air bearing surfaces was present in patented independent apparatus claim 1, (but was present in only newly presented claim 16)

which was subsequently allowed by the Examiner, further demonstrates the fallacy of the Examiner's assertion that the reissue claims must recite certain limitations that are present in some of the patented claims, but absent from other patent claims. If patented independent claim 1 lacks this "four separate air bearing surfaces" language, the Examiner can not properly require Applicant to include these elements in any of the reissue claims.

E. Where the Office Action Fails To Make A Finding Of In What Aspects The Reissue Claims Are Broader Than The Patent Claims, and Fails To Provide Evidence That The Broader Aspects Relate To Surrendered Subject Matter, The Rejection Must Be Withdrawn

The Examiner also asserts that:

The following limitations have been omitted from the newly presented reissue claims."

Nothing in 35 U.S.C. §251 requires that an applicant's claims of enlarging scope to be "related in scope to like process/method claims in the parent" patent. Where, as here, an applicant chooses to use different nouns and verbs to define his invention, nothing in 35 U.S.C. §251 authorizes the Examiner to maintain a rejection on the grounds now asserted by the Examiner, namely that the rejected claims are not "related in scope to like process/method claims in the parent" patent. The Examiner's reasoning is a *non sequitur* because claims of enlarging scope, by definition, must differ in scope, and can not therefore, be "related in scope to like process/method claims in the parent" patent. Consequently, the Examiner's reason given for refusing allowance of claims 21 through 60 is contrary to logic, unauthorized by statute, and should not be maintained upon reconsideration.

F. The Examiner's Rejection of Claims 21-60 Under 35 U.S.C. §251 Is An Improper, Back-door Attempt To Revive The *Point-of-novelty* Criterion For Patentability

The Examiner's assertion that claims 21 through 60 are related in scope to like apparatus claims in the parent which require the reasons stated in the prosecution history as discussed above to be present in the reissue claims, the Examiner is, in effect, improperly re-writing U.S.C. §251 to require that the reissue claims contain the same point-of-novelty language as the patented claims. This ignores the fact that the point-of-novelty test has been long discarded by the Court of Appeals, that 35 U.S.C. §251 contains no point-of-novelty criteria and that the statute, as represented by sections such as 35 U.S.C. §103(a), mandates that the Examiner must consider the subject matter claimed "as a whole", rather than as isolated limitations. Application of the point-of-novelty test ignores the fact that the reissue Applicant's inventions may be alternatively defined by the interaction of the combination of constituent elements, rather than by a single point-of-novelty phrase. It is therefore, unreasonable to expect, and there is no requirement under §251, that the re-issue claims slavishly parent the language of the patented claims.

G. Alternative Statements Made By An Applicant To Explain The Impropriety of A Rejection Under 35 U.S.C. §102 Are Not An Amendment Of The Claim And Do Not Constitute A Surrender Of Patentable Subject Matter Under 35 U.S.C. §251

The Examiner further argues the rejection of claims 21 through 60 on grounds that:

The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during prosecution of the application.

The language referred to by the Examiner is the language of the Applicant as written in the

Remarks, rather than the language of the patent claims, and that language demonstrates in two distinct paragraphs, **five** different reasons why Chapin '868 fails to anticipate patented claim 1. Applicant has no right of appeal from a decision by the Examiner who withdraws a rejection and passes an application to issue; consequently, whatever language may be employed by an applicant in the Remarks, does not create an estoppel or establish any basis for recapture, simply because the basis for the estopped lies in the language of the claims, not in a paraphrase of the language of the claims. Where, as here, the Examiner correctly accepted Applicant's alternative reasons for traversal, there is no basis for the Examiner during the reissue prosecution, to claim that arguments presented by Applicant establish a basis for recapture where the distinguishing features were not added to the claims by amendment.

Moreover, the Examiner's assertion that the rejected claims do not include an "arcuate front wall portion" and "third and fourth air bearing surfaces" is factually incorrect because the actual language of claim 1 is "a U-shaped projection...for defining a negative pressure cavity therein" and third and fourth air bearing surfaces." These features may be seen in the somewhat different language of rejected claims 21 and 31 which define "a U-shaped air bearing platform defining a negative pressure cavity" and "not more than two separate air bearing platforms".

As earlier explained herein, even assuming *ar guendo* the existenc e of some sort of bar to recapture in the instant application, the existence of that bar does not deny the Applicant the ability to broaden the scope of coverage by using *alternative language* to define his inventions. Nothing under the doctrine of recapture requires an Applicant to use the exact and precise language present in the patented claims. Furthermore, some of the patented claims, such as

independent apparatus claim 16, broadly define Applicant's alternative "four separate and distinct positive pressure areas." Accordingly, there is no basis for maintaining a rejection of claims 20 through 60 on grounds that these claims lack language mentioned either Applicant's Remarks or in other independent claims.

H. Even Ignoring Arguendo A Lack Of Basis For Imposition Of A Rejection Under The Doctrine Of Recapture And A Failure Of The Examiner To Follow The Mandated Procedure Under MPEP §1412.02, Claims 21 Through 60 Each Define At Least One Of The Constituent Aspects Required By The Examiner

Considering again the Examiner's argument that the rejection of claims 21 through 60 on grounds that:

The following limitations have been omitted from the newly presented reissue claims: "first and second projections" defining "first and second air bearing surfaces" (claims 21, 31, 42, 52, 55 and 58); "arcuate front wall portion" (claims 21, 31, as now amended 42, 52, 55, and 58), and "third and fourth air bearing surfaces" (claims 21, 52, 55, and 58).

In the amendment of 12/01/98 in the parent application Applicant specifically argued (see remarks on pages 11-12) the following structural features to defined over the 102 rejection based upon CHAPIN et al (5,200,868): (a) an arcuate front wall, (b) third and fourth air bearing surfaces, and (c) four separate air bearing surfaces."

the Examiner's attention is invited to the actual language of the rejected claims.

First, the Examiner supports this rejection by asserting that "the record of the application for the patent shows that the broadening aspect (in the reissue) relates to the subject matter that applicant has previously surrendered during the prosecution of the application." This is incorrect, and the Examiner has not been able to identify any surrender of any subject matter

during the prosecution of the parent application. Absent surrender, there is no basis to support the **Examiner's** averment of recapture. Withdrawal of this rejection is therefore required.

Second, the Examiner cites “the following limitations [as having] been omitted from the newly presented reissue claims: 'first and second projections' defining 'first and second air bearing surfaces' (claims 21, 31 and 42); 'arcuate front wall portion' (claims 21 and 31), and 'third and fourth air bearing surfaces' (claim 21).” The Examiner's assertions are factually incorrect on the record. Evidence of this is found in the Examiner's assertion that:

“In the amendment of 12/01/98 in the parent application Applicant specifically argued (see remarks on pages 11-12) the following structural features to defined [sic] over the 102 rejection based upon CHAPIN et al. (5,200,868,): (a) an arcuate front wall”, (b) third and fourth air bearing surfaces, and c) four separate air bearing surfaces.”

This is an incorrect reading of statement of fact presented in the paragraph bridging pages 11 and 12 of Applicant's Amendment of 1 December 1998. In that Amendment, Applicant simply explained that any one of six distinct features of claim 1 each independently serve to separately and alternatively distinguish claim 1 over Chapin '868, by explaining that:

- ① “Claims 1-3, 7, 9-19, and 21-25 are drawn to a negative pressure air bearing slider which includes “a *U-shaped projection ... including an arcuate front wall ... for defining a negative pressure cavity therein.*”
- ② The U-shaped projection also has first and second side wall portions “*for defining third and fourth air bearing surfaces.*”
- ③ Applicant respectfully submits that the claimed slider is not disclosed anywhere in Chapin. For example, Figure 3j cited by the Examiner shows a slider which clearly has

- ④ neither a U-shaped projection with an arcuate front wall portion for defining a negative pressure cavity,
- ⑤ nor does it have *third or fourth air bearing surfaces* spaced apart on the slider body.
- ⑥ Likewise, none of the numerous other embodiments shown in Chapin disclose a slider according to any of the claims 1-3, 7, 9-19, and 21-25.”

The foregoing excerpt from Applicant's 1998 Amendment clearly demonstrates that the Examiner's assertion about “four separate air bearing surfaces” is unfounded. This excerpt from Applicant's Remarks is written in the alternative; none of these features are shown by Chapin '868. In short, Applicant was, in this excerpt, simply explaining to the Examiner that *any one* of those six features in claim 1 were alone sufficient to individually, patentably distinguish claim 1 over Chapin '868 under 35 U.S.C. §102(b). Moreover, the issue is moot about the other two features, both of which are broadly contemplated by the rejected claim 21 through 51 as well as subsequently added claims 52 through 60. The Examiner's reliance upon Applicant's demonstration of the absence of a *prima facie* showing of anticipation by Chapin '868 is misplaced and is not helpful to completion of the examination.

Third, Applicant further explained on page 11 of the 1998 Amendment, that:

“Moreover, as can be clearly seen in Fig. 3j cited by the Examiner, Chapin's air bearing slider has the side rails 20 and 22 connected from leading edge to trailing edge without any broken sections. In contrast, in the air bearing slider according to the present claimed invention there are no side rails connected from leading edge to trailing edge. Instead, as shown in Fig. 4 and recited in independent claims 1 and 21, there are the four separate air bearing surface (ABS) platforms 110a, 110b, 110c and 110d distributed at the four edges of the surface. The two trailing platforms, 110c and 110d, are connected by cross rail 130 to create a negative pressure

pocket. This clearly distinguishes the slider of claims 1-3, 7, 9-19, and 21-25 of the present invention from Chapin.”

That statement illustrates, as was expressly stated, that the presence of four separate air bearing surfaces “clearly distinguishes” the claims argued over exemplary art references Chapin '868. That statement does not however, surrender any subject matter disclosed in the original application, and is directed to specific embodiments and implementations of Applicant's invention that are disclosed in the originally filed application and claimed by patent claim 16, although not by patent claim 1.

The Examiner's attention is also invited to the Applicant's demonstration, set forth on page 12 of Paper No. 6, of the complete absence of any similarity between the disclosures of Chapin '868 and the disclosure of Applicant's original specification. In a discussion contrasting Applicant's Fig. 4 with “Fig. 3j [of Chapin '868] cited by the Examiner, Applicant demonstrated a lack of anticipation. In that discussion of the drawings, Applicant wrote:

“Moreover, as can be clearly seen in Fig. 3j cited by the Examiner, Chapin's air bearing slider has the side rails 20 and 22 connected from leading edge to trailing edge without any broken sections. In contrast, in the air bearing slider according to the present claimed invention there are no side rails connected from leading edge to trailing edge. Instead, as shown in Fig. 4 and recited in independent claims 1 and 21, there are four separate air bearing surface (ABS) platforms 110a, 110b, 110c and 110d distributed at the four edges of the surface.” Applicant's *Remarks*, Paper No. 6, page 12.

The Examiner's interest in this comparison of the drawings is not explained in the Office Action. In this discussion Applicant is simply examining the detail of the very drawing of Chapin '868 used by the Examiner to support the anticipation rejection. This discussion is simply an

observation that the evidence relied upon by the Examiner to support the rejection under 35 U.S.C. §102(b) was inadequate. Moreover, in that discussion, Applicant did not refer to either “(a) an arcuate front wall” or “(b) third and fourth air bearing surfaces” as alleged by the Examiner here, but Applicant did refer to (c) four air bearing surfaces”, although, as is explained below, this was to show the existence of yet another basis that was alone sufficient to patentably distinguish claim 16 from Chapin ‘868 under 35 U.S.C. §102(b).

In the same paragraph of that discussion on page 12 of Paper No. 6, the Applicant further explained to the Examiner, by reference to the various elements illustrated in Applicant’s Fig. 4, that:

“The two trailing platforms, 110c and 110d, are connected by cross rail 130 to create a negative pressure pocket.” Applicant’s *Remarks*, Paper No. 6, page 12.

The significance of this distinction between Applicant’s Fig. 4 and Chapin’s Fig. 3j, was then emphasized by the Applicant’s subsequent statement:

“This clearly distinguishes the slider of claims 1-3, 7, 9-19, and 21-25 of the present invention from Chapin.” Applicant’s *Remarks*, Paper No. 6, page 12.

The particular language used by the Applicant, namely that “[t]he two trailing platforms, 110c and 110d, are connected by cross rail 130 to create a negative pressure pocket”, was used in the *Remarks* to explain this distinction between Applicant’s Fig. 4 and Chapin’s Fig. 3j and to thereby demonstrate that Chapin’s Fig. 3j could not possibly support an anticipation rejection of independent claim 1; however the features referred to by Applicant were defined by Applicant, albeit with other nouns and verbs, in both original claim 1 and in now reissue claims 21 through

60 of the rejected reissue claims.

Consequently, even ignoring *arguendo* the absence of an amendment creating a basis for a recapture investigation, the feature referred to by Applicant's explanation is present in all of the rejected reissue claims. There is therefore, no basis for a recapture rejection; consequently, the Examiner's reliance upon Applicant's explanation set forth in the *Remarks* of the 1998 Amendment, about the impropriety of the rejection under 35 U.S.C. §102(b) is improper, inaccurate and misplaced. Accordingly, withdrawal of the rejection is respectfully requested.

Fourth, as rejected under 35 U.S.C. §102(b) over Chapin '868 in Office Action No. 5, claim 1 **originally** recited "first and second projections ... to define first and second air bearing surfaces" That is, the phrases quoted by the Examiner were present in claim 1 prior to the rejection under §102(b). This provides no basis for asserting recapture.

Fifth, as rejected under 35 U.S.C. §102(b) over Chapin '868 in Office Action No. 6, claim 1 **originally** recited "a curved front wall portion" This clause was broadened by amendment, to read "arcuate front wall portion" The Examiner's assertion that "arcuate" was added by amendment is misleading; "arcuate" was substituted for "curved." The broadening of a claim can not serve as the foundation for a recapture rejection, because the broadening does not surrender any of Applicant's scope of coverage. Absent surrender, there is no recapture. To the contrary, the broadening enlarges the scope of coverage.

Sixth, as rejected under 35 U.S.C. §102(b) over Chapin '868 in Office Action No. 6, claim 1 **originally** recited "third and fourth air bearing surfaces" This feature was not added by amendment; consequently, there is no basis for asserting a recapture of a feature added to the

claims in order to overcome the rejection under 35 U.S.C. §102(b) as anticipated by Chapin '868 because this feature was already present in claim 1 prior to the rejection. The Examiner's assertion in paragraph 7, that "Applicant clearly amended the originally filed claims **to add ...** "third and fourth air bearing surfaces" is factually incorrect. Accordingly, a rejection premised upon incorrect statements of fact, must be withdrawn.

III. Rejection of Claims 21 through 41 Under Second Paragraph of 35 U.S.C. §112

In paragraph 3 of the Office action, the Examiner newly rejected claims 21 through 41 as being allegedly indefinite under the second paragraph of 35 U.S.C. §112. Applicant traverses this rejection for the following reasons.

Claim 21

The Examiner explained this rejection as justified because claim 21 "fails to recite any reference for the locations of the listed features." The Examiner fails to give any explanation for this statement. A careful reading of claim 21 establishes the presence of references for the locations of all of the constituent elements of claim 21:

"a body with a principal surface disposed to confront a recording surface of a recording medium, said principal surface having a lead portion and a rear portion, said lead portion being spaced upstream from said rear portion relative to a rotational direction of any recording medium confronted by said slider, said lead portion having a front edge, said rear portion having a rear edge, said front edge and said rear edge together defining boundaries of said principal surface in a longitudinal direction of said slider body", and

"said front edge and said rear edge together defining boundaries of said principal surface in a longitudinal direction of said slider

body... ”

Dissection of this language confirms the presence of references for the locations of each of these constituent elements relative to “a recording surface of a recording medium”:

Principal surface:	disposed to confront a recording surface of a recording medium.
Said principal surface:	having a lead portion and a rear portion.
Said lead portion:	being spaced upstream from said rear portion relative to a rotational direction of any recording medium confronted by said slider.
Said lead portion:	having a front edge.
Said rear portion:	having a rear edge.
Said front edge and said rear edge <i>together</i> :	defining boundaries of said principal surface in a <i>longitudinal direction</i> of said slider body.

In summary, the *principal surface*, the *lead portion* and *rear portion* are located by reference respectively to the *recording surface* of a recording medium and the relative directions of upstream from one another, *relative to a rotational direction* of any recording medium confronted by said slider. Moreover, the *lead portion* is defined as having a *front edge* while the *rear portion* is defined as having a *rear edge*, and the *front edge* and *rear edge together* are said to define “boundaries of said principal surface in a *longitudinal direction* of said slider body.”

In summary, each and every one of the constituent elements defined by claim 21, are related by reference to location for both the slider body and any recording medium confronted by the slider body. There is therefore, no basis for maintaining this rejection.

Claim 31

In explaining the rejection of claim 31, the Examiner states that claim 31 “fails to recite a reference for the ‘first direction.’” The Examiner also noted that the “patented claims” referenced features to the rotational direction confronted by the slider. Claim 31 already recites,

“a principal surface defining a first plane tangential to a first direction, said principal surface having a lead portion and a rear portion, said lead portion being spaced upstream from said rear portion relative to said first direction, said lead portion having a front edge, said rear portion having a rear edge, said front edge and said rear edge together defining longitudinal boundaries of said principal surface in said first direction.”

Careful examination of the excerpted language of claim 31 establishes that each of the constituent elements defined within the text of claim 31 are defined as having locations and those locations are related to the “principal surface” and, in the subsequent text of claim 31, the “U-shaped airbearing platform” is related to both the “principal surface” and to the “first direction”:

A principal surface: defining a first plane tangential to a *first direction*.

Principal surface: having a lead portion and a rear portion.

Said lead portion: being spaced upstream from said rear portion relative to said first direction.

Said lead portion: having a front edge.

Said rear portion: having a rear edge.

Said front edge and
said rear edge *together*: defining longitudinal boundaries of said principal surface in said first direction.

Each and every one of the constituent elements defined by claim 31, are related by reference to location for both the slider body and any recording medium confronted by the slider body. There

is therefore, no basis for maintaining this rejection.

IV. Rejection of Claims 21 - 60 Under First & Second Paragraphs of 35 U.S.C. §112

In paragraph 4 of the Office action, the Examiner again rejected claims 21 through 51 under the first and second paragraphs of 35 U.S.C. §112, based upon the Examiner's averment, repeated verbatim from Paper No. 6, that "the claimed invention is not described in such full, clear, concise, and exact terms as to enable any person skilled in the art to make and use the same, and/or for filing to particularly pointing out and distinctly claim the subject matter which applicant regards as the invention." Applicant respectfully traverses this rejection for the following reasons:

First, the Examiner's characterization of Applicant's invention is extremely broad, but fails to satisfy the statute. Under 35 U.S.C. §112, the Congress gave exclusive and sole authorization to the inventor, not to the Examiner, to determine "the subject matter which the applicant regards as his invention." See the second paragraph of 35 U.S.C. §112. While the Examiner's thoughts about the novelty disclosed by Applicant in the specification are appreciated, it is Applicant alone, rather than the Examiner, who has been authorized by the Congress of the United States, to determine the subject matter of his invention. The fact that Applicant seeks broad coverage for his invention by defining combinations of different salient features, has nothing to do with enablement, if those features have been properly disclosed. Both the OG figure, and other figures, such as Figures 9 and 10, clearly show structures defined by the newly presented claims, including newly presented claims 52, 55 and 58, with a "U-shaped air

bearing platform defining a negative pressure cavity on said principal surface.” The fact that particular implementations of Applicant's inventions as defined by claims 21 through 60 may require additional structure such as an armature, a voice coil motor, a transducer and a sealed container are irrelevant to determinations of novelty. Novelty is determined by the scope of the art relative to the prior art. Consequently, the breadth of Applicant's pending claims provides no basis for rejecting these claims under either the second or the first paragraph of §112; accordingly, this rejection is improper, has no authority under the statute and must be withdrawn.

Second, the Examiner argues that the original disclosure “showed only slider configurations with two separate front air bearing surfaces and a [*sic*, an] U-shaped cross rail with a side extension on each side terminating near the rear edge with an air bearing surface. There is NO disclosure of a slider having: (a) a cross rail without the two separate front air bearing surfaces, (b) a cross rail with only one side extension, (c) only a total of one air bearing surface between the two side extensions, or (d) the side extensions having different lengths, with only one terminating before the trailing end of the slider.” These four averments bear individual consideration.

(a) cross rail without the two separate front air bearing surfaces

This averment incorrectly reads Applicant's claims. By way of example, rejected claim 21 defines *inter alia*,

“a U-shaped air bearing platform defining a negative pressure cavity on said principal surface, said U-shaped air bearing platform comprising not more than two separate air bearing platforms each extending rearwardly toward said rear portion of said principal surface”

Nowhere in either claim 21, nor in any of the other rejected claims, do the words “without” or “cross rail without”, or even “without the two separate front air bearing surfaces” appear. Absent the presence of these words from any of the rejected claims, the questions of enablement, written description and indefiniteness focused upon the clause “cross rail without the two separate front air bearing surfaces” are immaterial to the patentability of claims 21 through 60.

(b) a cross rail with only one side extension

This averment is inaccurate. Rejected claim 21 reads:

“a U-shaped air bearing platform defining a negative pressure cavity on said principal surface, said U-shaped air bearing platform comprising not more than two separate air bearing platforms each extending rearwardly toward said rear portion of said principal surface and respectively terminating at a first rear termination and a second rear termination, at least one of said not more than two separate air bearing platforms including a side wall portion”

Neither claim 21, nor any of the other rejected claims uses the clause *a cross rail with only one side extension*. Whether this clause is enabled, described in a written description, or indefinite has no bearing upon the patentability of claims 21 through 60.

(c) only a total of one air bearing surface between the two side extensions

This averment misreads the text of all of the rejected claims. By way of example, claim 21 reads:

“a U-shaped air bearing platform defining a negative pressure cavity on said principal surface, said U-shaped air bearing platform

comprising not more than two separate air bearing platforms each extending rearwardly toward said rear portion of said principal surface and respectively terminating at a first rear termination and a second rear termination, at least one of said not more than two separate air bearing platforms including a side wall portion”

Neither the words “only”, “total”, “one air bearing surface”, nor the clauses “only a total of one air bearing surface” or “total of one air bearing surface between the two side extensions” appear in either claim 21 or in any of the other rejected claims. Absent the presence of these words from any of the rejected claims, the questions of enablement, written description and indefiniteness of the clause (c) only a total of one air bearing surface between the two side extensions” are immaterial to the patentability of claims 21 through 60.

(d) the side extensions having different lengths, with only one terminating before the trailing end of the slider

This averment improperly reads into the rejected claims, words that are not present in those claims. Claim 21, as exemplary of the rejected claims, states:

“at least one of said first rear termination and said second rear termination not coinciding with said rear edge, and being disposed upstream of said rear edge relative to said rotational direction of said recording medium.”

Nothing in this claim states “side extensions having different lengths, with only one terminating before the trailing end of the slider.” Accordingly, absent the words “only”, “the side extensions having different lengths”, “with only one”, or “with only one terminating before the trailing end of the slider”, there is no basis for maintaining this rejection.

V. Rejection Of Claims 21, 30-32, and 41 Under 35 U.S.C. §102(a) Over Nepela '981

In paragraph 6 of the Office action, the Examiner rejected claims 21, 30-32, and 41 under 35 U.S.C. §102 for alleged anticipation by Nepela *et al.* U.S. Patent No. 5,568,981. Applicant respectfully traversed this rejection for the following reasons.

Although the Examiner asserts that Figs. 4b, 4c, 5b, 5c and 5d of Nepela '981 show “a slider with an U-shaped platform with a negative pressure cavity (not numbered) behind a cross rail 98”, these drawings of Nepela '981 uniformly illustrate three discrete elements, namely side rails 72, 74 and cross rail 98 forming what the Examiner alleges to be a *U-shaped platform*. These drawings fail to show Applicant's “U-shaped air bearing platform defining the negative pressure cavity” with “said U-shaped air bearing platform comprising not more than two separate air bearing platforms ...” as defined by claims 21, 31, 52, 55 and 58. Under the *all-elements* rule of an interpretation of 35 U.S.C. §102(a), if *any element* of rejected claim is missing from the applied art, there can be no anticipation. Accordingly, Nepela'981 fails to anticipate any of these claims. Accordingly, this rejection may not be maintained under the *all elements* rule of 35 U.S.C. §102(b).

VI. Explanation of Support under 37 CFR §1.173(c)

Claim 16 is amended in line 3 to change “slider” to “slider body” in conformance with the introduction of this phrase in line 2 of claim 16. Support is provided in the language of original claim 16.


No Petition or fee for an extension of time is required by the filing of this paper.

Entry of this Amendment under 37 CFR §1.116(b) is indicated, because no new issues are

raised by the amendment of claim 16; no new issues are raised by this amendment which address antecedent basis; and no further search or consideration is required because this amendment uses language taken from the earlier introduced language of claim 16. Alternately, entry in part is requested.

In view of the above, all claims are deemed to be allowable and this application is believed to be in condition to be passed to issue. Reconsideration of the rejections and objections is requested. Should any questions remain unresolved, the Examiner is requested to telephone Applicant's attorney.

Respectfully submitted,



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